

## REMARKS

### SUMMARY

In the Office Action of May 14, 2004, the Examiner rejected all the original claims based on 35 U.S.C. §103(a) in view of Huber '183 and Barber '504. Applicant believes that the rejection based on 35 U.S.C. §103(a) should be withdrawn in view of the following Remarks. The specification is also amended to revise a priority claim. This amendment to the specification does not add new matter.

### PRIORITY CLAIM

It is noted that the priority claim should only be made with respect to U. S. Serial No. 09/992,806, now U. S. Patent No. 6,755,215 B2 (herein parent case), which was co-pending at the time the above-identified application was filed. The other utility application referred to, namely, Serial No. 09/401,252 based on provisional application Serial No. 60/101,758, issued on July 31, 2001, as U. S. Patent No. 6,267,001 B1 (herein other Duncan case), has an issue date prior to the filing date of the above-identified application and its parent case. Therefore, a priority claim could not be based on the other Duncan case.

When the Attorney for the Assignee, John J. Connors, reviewed the parent case, he noted that the Declaration signed by the Applicant, Scott Duncan, indicated that priority was claimed based on the other Duncan case. The Attorney for the Assignee mistakenly believed an oversight had occurred in not including a specific reference to other Duncan case in the

specification of the parent case as required under 35 U.S.C. §120. Consequently, he filed in the parent case a petition under C.F.R. §1.78(a)(3), to add a specific reference to the other Duncan case in the specification of the parent case and perfect the priority claim. He also included in the specification of the above-identified application a specific reference to the other Duncan case. The petition was subsequently dismissed because of the patenting of the other Duncan case prior to the filing date of the parent case.

#### REJECTION UNDER 35 U.S.C. §103(a)

##### Hindsight Approach

The hindsight approach adopted by the Examiner in rejecting the claims is objected to. It is well settled law that such an approach is strictly prohibited. After considering Applicant's claims, the Examiner has selected the prior art references Huber '183 and Barber '504 showing ***some*** individual features that may be similar to certain elements of Applicant's invention. There is nothing in these references, however, suggesting Applicant's claimed invention.

The correct way to resolve the question of obviousness is to follow the approach set forth in Graham v. John Deere, 383 US 1, 17, 148 USPQ 459, 467 (1966). In this case, the U. S. Supreme Court directed that three factual inquiries be made. These factual inquiries are:

1. Determining the scope and content of the prior art.
2. Ascertaining the difference between the prior art and the

claims at issue.

3. Resolving the level of skill in the pertinent art.

The Court of Appeals for the Federal Circuit in In re Fritch, 23 USPQ 2d 1780, deals specifically with obvious determinations. In Fritch, the Court on page 1783 states:

**"The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification."**

As provided in M.P.E.P. Section 2143, before a *prima facie* case of obviousness under 35 U.S.C. 103(a) can be established, the following criteria must be met:

- 1) There must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art to modify the reference or to combine the reference teachings;
- 2) There must be a reasonable expectation of success; and
- 3) The prior art references must teach or suggest all the claim limitations.

Applicant believes that the substantial evidence requirement established by In re Kotzab, 217 F. 3d 1365 (Fed. Cir. 2000), is lacking. In re Kotzab states:

A claimed invention is unpatentable if the differences between it and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art. See 35 U.S.C. § 103(a) (Supp. III 1997); In re Dembiczak, 175 F.3d 994, 998, 50 USPQ2d 1614, 1616 (Fed. Cir. 1999). The ultimate determination of whether an invention would have been obvious under 35 U.S.C. § 103(a) is a legal conclusion based on underlying findings of fact. See Dembiczak, 175 F.3d at 998, 50 USPQ2d at 1616. We review the Board's ultimate determination of obviousness de novo. See id. However, we review the Board's underlying factual findings for substantial evidence. See In re Gartside, 203 F.3d 1305, 1316, 53 USPQ2d 1769, 1776 (Fed. Cir. 2000).

In re Kotzab further states:

A critical step in analyzing the patentability of claims pursuant to section 103(a) is casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field. See Dembiczak, 175 F.3d at 999, 50 USPQ2d at 1617. Close adherence to this methodology is especially important in cases where the very ease with which the invention can be understood may prompt one "to fall victim to the insidious effect of a hindsight syndrome wherein that which only the invention taught is used against its teacher." Id. (quoting W.L. Gore & Assocs., Inc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 313 (Fed. Cir. 1983)).

Most if not all inventions arise from a combination of old elements. See In re Rouffet, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457 (Fed. Cir. 1998). Thus, every element of a claimed invention may often be found in the prior art. See id. However, identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention. See id. Rather, to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the applicant. See In re Dance, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998); In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984). Even when obviousness is based on a single prior art reference, there must be a showing of a suggestion or motivation to modify the teachings of that reference. See B.F. Goodrich Co. v. Aircraft Breaking Sys. Corp., 72 F.3d 1577, 1582, 37 USPQ2d 1314, 1318 (Fed. Cir. 1996).

### Failure to Meet the Substantial Evidence Requirement

The evidence is that Huber '183 and Barber '504 disclose a barrier device for a waterline comprising several separate and distinct components that must be assembled on site and held together to provide the barrier. In contrast, Applicant's invention comprises a "...single piece body..." (Independent Claims 1, 7 and 13), There is

nothing in either Huber '183 or Barber '504 suggesting a waterline barrier comprising a "...single piece body..." Consequently, the substantial evidence requirement has not been met.

#### Scope and Content of Prior Art:

The Examiner relies on Huber '183 and Barber '504, both of which disclose a barrier consisting of separate elements.

#### Differences between Prior Art and Claims:

One major difference between the references relied upon and Applicant's invention is that Applicant's barrier is a "...single piece body..." All the independent claims include this limitation. The Examiner acknowledges this difference, and states: "It would have been obvious ...to form the cylindrical wall and planar disk as a single, unitary body, since it has been held that forming in one piece an article which has formerly been formed in two pieces and put together involves only routine skill in the art."

There are advantages to a "...single piece body..." which include, but are not limited to: (a) lower installation cost because of the simplicity and time saving involved in connecting the barrier between the two pipes of the waterline and (b) lower production cost due to the use of a single mold to make the barrier with a "...single piece body..." Both Huber '183 and Barber '504 fail to discuss at all a barrier with "...single piece body..." ; they are apparently ignorant of the above advantages associated with a "...single piece body..." Or perhaps, they think it cannot be done. But most

importantly, they are silent. The Examiner, using hindsight, and without any reference to any prior art, or case law, or the USPTO Rules, or the MPEP, simply states " ...it has been held that forming in one piece an article which has formerly been formed in two pieces and put together involves only routine skill in the art." Under what circumstances has it been so held? Forming a single piece article from multiple pieces that have been formerly held together in some fashion may or may not be obvious under the particular circumstances. What maybe obvious in one situation may not be obvious in another situation. Notwithstanding that there is nothing in either Huber '183 or Barber '504 that suggests a barrier having a "...single piece body...", the Examiner concludes that Applicant's invention is obvious. There is no support for the Examiner's conclusive statement quoted above. This is clearly an erroneous application of the standard of 35 U.S.C. §103(a) contrary to the mandate of Graham v. John Deere.

#### Level of Skill in the Pertinent Art:

One way to ascertain the level of skill in the pertinent art is to examine the references cited. None of these references in any way suggest a barrier having a "...single piece body..." This is indicative of the skill in the art to which Applicant's invention is related.

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In view of the above, the application is deemed to be in a condition for allowance and such action is solicited.